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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/688,142	10/16/2000	Gary Crance	06975-070001	9995
26171	7590	07/09/2004	EXAMINER	
FISH & RICHARDSON P.C. 1425 K STREET, N.W. 11TH FLOOR WASHINGTON, DC 20005-3500			KIM, JUNG W	
		ART UNIT		PAPER NUMBER
		2132		10
DATE MAILED: 07/09/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/688,142	CRANCE, GARY
	Examiner Jung W Kim	Art Unit 2132

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) This action is FINAL.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-51 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-51 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 16 October 2000 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____.   |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>5</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____.                                   |

## **DETAILED ACTION**

1. Claims 1-51 have been examined. Applicant has amended claims 1-5, 8, 9, 12, 15, 18, 23-27, 30, 31, 36, and 42-51 in the preliminary amendment filed on May 14, 2001.

### ***Drawings***

2. New corrected drawings are required in this application because the drawings are informal (Figures 10-16). Applicant is advised to employ the services of a competent patent draftsperson outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The requirement for formal drawings will be held in abeyance until a Notice of Allowance is submitted.

### ***Specification***

3. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. The following title is suggested: 'Method and system for preventing users from capturing digital content while perception of digital content is enabled'.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1, 3, 10, 23, 25, 32, 41, 42, 44, and 51 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. Claim 1 recites the limitations "the user" and "the presence". There is insufficient antecedent basis for these limitations in the claim.

7. Claim 3 recites the limitations "the same size" and "the same location". There is insufficient antecedent basis for these limitations in the claim.

8. Claim 23 recites the limitations "the user" and "the presence". There is insufficient antecedent basis for these limitations in the claim.

9. Claim 42 recites the limitations "the user" and "the presence". There is insufficient antecedent basis for these limitations in the claim.

10. As per claim 41, the presence of the trademark or trade name JAVA is not proper under 35 U.S.C. 112, second paragraph (see 37 CFR 2173.05(u)). If a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of the 35 U.S.C. 112, second paragraph. Ex parte Simpson, 218 USPQ 1020 (Bd. App. 1982). The scope of the claim is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product.

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11. Claims 1, 10, 23, 32, 42, and 51 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: 1) presenting an indicator to a user in a browser: this step is essential since this step precedes the step of preventing the user from perceiving the content while the indicator is being presented, and further, the step requires means to present the indicator and corresponding content in a computer-implemented method; 2) replacing the indicator with the content (after the step of receiving a request from the user): this step is essential since in the preceding step, the user is prevented from perceiving the content while the indicator is presented; 3) preventing a perception of the content by replacing the content with the indicator whenever the user attempts to capture the content using a browser application that captures displayed content: this step is critical since only the presentation of the indicator prevents the user from perceiving the content, and only when the user attempts to use a capture feature of the browser application while perceiving the content is the capture feature disabled (for example, when implementing the applicant's method/system/apparatus, a user would still be able to take a photograph of the perceived content using a hand held camera, and thus "capturing" the content). These omitted steps are further necessary to particularly point out and distinctly claim the subject matter of the invention as enabled by the specification.

12. Claims 1, 23, and 42 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements,

such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are: 1) browser for displaying an indicator and corresponding content; 2) graphical interface tool to submit a request by the user to perceive the content; 3) browser application used by the user to capture the content presented in the browser. Since the claims define a method and apparatus in terms of a computer implementation, wherein a user can perceive the indicator and content, the claims must define a structural relationship between the computer-implemented method/system/software and the content. These omitted structural relationships are further necessary to particularly point out and distinctly claim the subject matter of the invention as enabled by the specification.

13. The term "substantially" in claims 3, 25, and 44 is a relative term which renders the claim indefinite. The term "substantially" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. The size and location of the image is rendered indefinite by the term "substantially".

***Claim Rejections - 35 USC § 102***

14. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

15. Claims 1-3, 8-9, 11-17, 23-25, 30-31, 33-35, 42-44, and 49-50 are rejected under 35 U.S.C. 102(e) as being anticipated by Nguyen U.S. Patent No. 6,032,150 (hereinafter Nguyen). As per claim 1, Nguyen discloses a computer-implemented method of protecting content, the method comprising:

- a. presenting an indicator that differs from the content and indicates the presence of the content (see Nguyen, col. 3, lines 17-21; Figure 1, Reference Nos. 122, 123, and 124);
- b. preventing the user from perceiving the content while the indicator is being presented (see Nguyen, col. 3, lines 31-33; Figure 1, Reference No. 122);
- c. receiving a request from a user to access the content (see Nguyen, col. 3, lines 14-17; Figure 1, Reference No. 111);
- d. enabling a user to perceive the content based on the request received from the user (see Nguyen, col. 3, lines 31-35; Figure 1, Reference No. 124); and
- e. preventing the user from capturing the content (see Nguyen, col. 3, lines 62-65; Figure 1, Reference No. 124).

The aforementioned covers claim 1.

16. As per claim 2, Nguyen discloses a method as outlined above in the claim 1 rejection under 35 U.S.C. 102(e). In addition, the step of preventing the user from

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capturing the content includes preventing the user from capturing the content while perception of the content is enabled (see Nguyen, col. 3, lines 62-65).

17. As per claim 3, Nguyen discloses a method as outlined above in the claim 1 rejection under 35 U.S.C. 102(e). In addition, the content is an image and the indicator includes a display area that has substantially the same size as the image and is positioned at substantially the same location as the image (see Nguyen, Figure 1, Reference Nos. 122, 123, and 124).

18. As per claims 8 and 9, Nguyen discloses a method as outlined above in the claim 1 rejection under 35 U.S.C. 102(e). In addition, the step of preventing the user from capturing the content comprises preventing the user from accessing an application of a browser used to produce the browser window that is otherwise capable of at least one of copying and saving the content (see Nguyen, col. 3, lines 12-39 and lines 62-65; claims 8 and 15).

19. As per claim 11, Nguyen discloses a method as outlined above in the claim 1 rejection under 35 U.S.C. 102(e). In addition, the content comprises an image and the step of enabling the user to perceive the content includes displaying the image (see Nguyen, col. 3, lines 12-24 and lines 30-34).

20. As per claims 12-17, Nguyen discloses a method as outlined above in the claim 1-9 and 11 rejections under 35 U.S.C. 102(e). In addition, the indicator includes an icon that differs from the content and indicates a presence of the content; moreover, the functions of the indicator outlined above are also functions of the icon (see Nguyen, Figure 1, Reference No. 123; col. 3, lines 31-34; col. 1, lines 29-53). The aforementioned cover claims 12-17.

21. As per claim 23, Nguyen discloses a method as outlined above in the claim 1 rejection under 35 U.S.C. 102(e). In addition, the method comprises a network of computers having communications links for receiving content from a network, wherein each computer has an output device for making received network content perceivable and an input device for receiving user input (see Nguyen, col. 2, lines 40-60). Furthermore, each limitation defined in claim 1 has corresponding code instructions stored in memory and performed by each computer in the network having communication links (see Nguyen, claim 15). The aforementioned covers claim 23.

22. As per claims 24-25, 30-31, 33 and 35, they are system claims corresponding to claims 2-3, 8-9, 11 and 23, and they do not teach or define above the information claimed in claims 2-3, 8-9, 11, and 23. Therefore, claims 24-25, 30-31, 33, and 35 are rejected as being anticipated by Nguyen for the same reasons set forth in the rejections of claims 2-3, 8-9, 11, and 23.

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23. As per claim 34, Nguyen discloses a method as outlined above in the claim 1 rejection under 35 U.S.C. 102(e). In addition, the software instructions enable perception of the content from a webpage (see Nguyen, Abstract).

24. As per claim 42, Nguyen discloses a system as outlined above in the claim 23 rejection under 35 U.S.C. 102(e). In addition, the system protects the content by performing operations on computer software (see Nguyen, claim 15). Furthermore, each code instruction performing a feature of the system is a logical code segment related to that feature. Hence, the aforementioned covers claim 42.

25. As per claims 43-44 and 49-50, they are apparatus claims corresponding to claims 24-25, 30-31 and 42, they do not teach or define above the information claimed in claims 24-25, 30-31, and 42. Therefore, claims 43-44 and 49-50 are rejected as being anticipated by Nguyen for the same reasons set forth in the rejections of claims 24-25, 30-31, and 42.

### ***Claim Rejections - 35 USC § 103***

26. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

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27. Claims 4-7, 18-21, 26-29, 36-39, 41, and 45-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nguyen in view of Lemay et al. Teach Yourself Java 2 in 21 Days (hereinafter Lemay). As per claim 4, Nguyen discloses a method as outlined above in the claim 1 rejection under 35 U.S.C. 102(e). Nguyen does not expressly disclose the indicator comprising text with instructions for securely viewing the content. However, as taught by Lemay, the applet used to secure graphical objects in the invention disclosed by Nguyen, can be implemented in various contexts and adapted to feature many different types of user interfaces and user input (see Lemay, pages 175-200 'Putting Interactive Programs on the Web', pages 233-267 'Adding Images, Animation, and Sound', pages 269-291 'Building Simple User Interfaces for Applets', pages 320-351 'Responding to User Input in an Applet', and pages 353-380 'Developing Advanced User Interfaces with the AWT'). One of these features includes adding labels to an applet that instructs a user to actuate an action using a graphical interface tool (see Lemay, pages 273-274, 'Labels'; page 275, 'Buttons', second bullet, 'Button(String)'; page 276, Figure 11.3). It would be obvious to one of ordinary skill in the art at the time the invention was made to apply the teaching of Lemay to the invention disclosed by Nguyen. Motivation for such a combination enables a method that is user and programmer friendly as taught by Lemay (see Lemay, page 269, 2<sup>nd</sup> and 3<sup>rd</sup> paragraphs).

28. As per claim 5, Nguyen covers a method as outlined above in the claim 4 rejection under 35 U.S.C. 103(a). In addition, the step of enabling the user to perceive

the content includes presenting the content to the user when the user requests access to the content by at least positioning a graphical interface tool over the indicator (see Nguyen, col. 3, lines 12-21; Lemay, pages 275-276, 'Buttons').

29. As per claims 6 and 7, Nguyen covers a method as outlined above in the claim 5 rejection under 35 U.S.C. 103(a). In addition, the step of preventing the user from capturing the content comprises preventing the user from using a single device to both present and capture the content (see Nguyen, Figure 1, Reference No. 110; col. 3, lines 62-65). The aforementioned cover claims 6 and 7.

30. As per claim 18, Nguyen covers a method as outlined above in the claim 4 rejection under 35 U.S.C. 103(a). In addition, the content is described in a hypertext markup language (see Lemay, pages 184-189, '<APPLET> tag').

31. As per claim 19, Nguyen covers a method as outlined above in the claim 18 rejection under 35 U.S.C. 103(a). In addition, the step of receiving a request from the user to access the content comprises receiving instructions from a user to access a document, the instructions including a network address of the document (see Nguyen, col. 3, lines 5-10 and lines 53-57; see Lemay, pages 245-246, 'Retrieving and Using Images' and 'Relative File Paths').

32. As per claims 20 and 21, Nguyen covers a method as outlined above in the claim 19 rejection under 35 U.S.C. 103(a). In addition, the content generated by an applet includes sound and text (see Nguyen, col. 1, lines 18-20; see Lemay, 263-266, 'Retrieving and Using Sounds').

33. As per claims 26-29 and 36-39, they are system claims corresponding to claims 4-7, 18-21 and 23, and they do not teach or define above the information claimed in claims 4-7, 18-21, and 23. Therefore, claims 26-29 and 36-39 are rejected as being unpatentable over Nguyen in view of Lemay for the same reasons set forth in the rejections of claims 4-7, 18, 19-21, and 23.

34. As per claim 41, Nguyen covers a system as outlined above in the claim 26 rejection under 35 U.S.C. 103(a). In addition, the software instructions are stored as a JAVA applet (see Lemay, entire document).

35. As per claims 45-48, they are apparatus claims corresponding to claims 26-29 and 42, and they do not teach or define above the information claimed in claims 26-29 and 42. Therefore, claims 26-29 and 42 are rejected as being unpatentable over Nguyen in view of Lemay for the same reasons set forth in the rejections of claims 26-29 and 42.

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36. Claims 22 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nguyen in view of Lemay, and further in view of Huseby 'Video on the World Wide Web Accessing Video from WWW Browsers' (hereinafter Huseby). As per claim 22, Nguyen covers a method as outlined above in the claim 19 rejection under 35 U.S.C. 103(a). Although neither Nguyen nor Lemay discloses the protected content as including video information, it is well known in the art for digital video to be presented using an applet run on a browser. For example, Huseby teaches a sample java video applet run in a Netscape browser (see Huseby, page 4, Figure 4.4). It would be obvious to one of ordinary skill in the art at the time the invention was made for the content prevented from user capture to include video, since copyright issues regarding video viewed in a browser are analogous to the copyright issues regarding browser displayed text, digital sounds and images.

37. As per claim 40, it is a system claim corresponding to claims 22 and 23, and it does not teach or define above the information claimed in claims 22 and 23. Therefore, claim 40 is rejected as being unpatentable over Nguyen in view of Lemay and Huseby for the same reasons set forth in the rejections of claims 22 and 23.

38. Claims 10, 32, and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nguyen in view of Mast U.S. Patent No. 5,881,287 (hereinafter Mast). As per claim 10, Nguyen covers a method as outlined above in the claim 1 rejection under 35 U.S.C. 102(e). Nguyen does not disclose the step of preventing a

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perception of the content whenever the user attempts to capture the content. Mast teaches a method for filling a protected content with a pattern or message and leaving the unprotected content "as is" when a user attempts to capture digital content (see Mast, Figure 8 and related text). It would be obvious to one of ordinary skill in the art at the time the invention was made to apply the teaching of Mast to the invention of Nguyen. Motivation for such an implementation enables selective capture of digital content of only unprotected regions.

39. As per claims 32 and 51, they are apparatus claims corresponding to claims 10, 23 and 42, and they do not teach or define above the information claimed in claims 10, 23, and 42. Therefore, claims 32 and 51 are rejected as being unpatentable over Nguyen in view of Mast for the same reasons set forth in the rejections of claims 10, 23, and 42.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Lesk U.S. Patent No. 5,905,505.

Schreiber et al. U.S. Patent No. 6,209,103.

Pizano et al. U.S. Patent No. 6,731,756.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jung W Kim whose telephone number is (703) 305-8289. The examiner can normally be reached on M-F 9:00-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on (703) 305-1830. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jung W Kim  
Examiner  
Art Unit 2132

Jk  
June 29, 2004



GILBERTO BARRON  
SUPERVISORY PATENT EXAMINER  
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